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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,300	06/05/2001	Matthew A. Parker	1510.1001	5700

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EXAMINER

GOTTSCALK, MARTIN A

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,300

Applicant(s)

PARKER, MATTHEW A.

Examiner

Martin A. Gottschalk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/05/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-23 have been examined.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, exemplary claim 1 recites "...charging a membership fee to allow a plurality of members to belong to the organization...[to visit doctors]...wherein the organization does not provide health insurance, but provides additional medical care regardless of any health insurance a member may already possess." The Examiner considers entitlement to future health care in exchange for a fee to comprise the essence of health insurance, thus the claim taken as a whole appears to be contradictory when it states the organization does not provide health insurance. For the purpose of examination, the Examiner will consider the claim to mean "...wherein the organization does not provide *primary* health insurance..." etc. Claims 22 and 23 make the same recitation as claim 1, and claims 2-21 depend from claim 1, thus they are rejected on the same basis as claim 1.



***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 2, 8-14, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonin (US PG Pub# 2002/0116233, hereinafter Bonin) in view of Thomas (US PG Pub# 2002/0138309, hereinafter Thomas).

A. As per claim 1, Bonin discloses a method of providing preferred patient services, comprising:

associating a plurality of doctors (Bonin: Fig. 1, item 10, reads on "Select Participating Physicians...") in various locations (Bonin: [0040], reads on "...a plurality of primary care physicians selected on the basis of



geographic location.”) with an organization (Bonin: Fig 1. The Examiner considers the execution of the various steps of Fig 1 to be a form of creating an organization to make and market the disclosed videotapes. The Examiner further considers the selected “participating physicians” to be associated with the organization.”), the associated doctors being selected by the organization based on each doctor's respective credentials (Bonin: [0006].).

Bonin fails to explicitly disclose

charging a membership fee to allow a plurality of members to belong to the organization, the members being permitted to seek any number of visits with any of the associated doctors in any of the various locations

wherein the organization does not provide health insurance, but provides additional medical care regardless of any health insurance a member may already possess

However, these features are well known as evidenced by the teachings of Thomas. Thomas discloses

charging a membership fee to allow a plurality of members to belong to the organization, the members being permitted to seek any number of



visits with any of the associated doctors in any of the various locations (Thomas: [0006]. The Examiner considers the “rebate” as described to be a form of payment of a membership fee in the sense that it is paying for membership to an organization that will provide or pay for health care services. Note the statement that the account can be used to pay for purchases of “different kinds” of insurance policy premiums or for “various services” associated with an insurance policy).

wherein the organization does not provide health insurance, but provides additional medical care regardless of any health insurance a member may already possess (Thomas: [0029]. The Examiner notes that “gap insurance” is not primary insurance, but provides additional medical care not covered by a primary policy. See section 112, paragraph 2 rejection above.).

It would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the teachings of Thomas within the method of Bonin. Bonin teaches a method for selecting a primary care physician (Bonin: [0005]), while Thomas teaches a method of paying for health care (Thomas: [0006]). The skilled artisan would have recognized the utility of combining the selection of a doctor with payment of the premium for the insurance that would subsequently reimburse the doctor for any service rendered, the motivation of the combination



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being to improve the capacity of the individual seeking medical care to pay for the medical care sought (Thomas: [0004] – [0005]).

Note: the same motivation to combine references applies to claims 2, 14, and 18-20 which follow in this section.

B. As per claim 2, Thomas discloses a method as recited in claim 1, wherein the organization is promoted through a credit card company (Thomas: [0041]).

C. As per claims 8 and 9, Bonin discloses a method as recited in claim 1 wherein the various locations comprise various

(claim 8) cities;

and

(claim 9) countries (Bonin: [0040]. The Examiner considers the disclosed "...useful grouping of primary care physicians selected on the basis of geographic location...where the physicians provide their service..." to include groupings based on cities and countries).

D. As per claim 10, Bonin discloses a method as recited in claim 1, wherein the selected doctors comprises a preexisting network of doctors (Bonin: [0040],



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reads on "...physicians provide their service in conjunction with several clinic facilities or hospitals.").

E. As per claims 11 and 12, Bonin discloses a method as recited in claim 1, wherein a member can access a list of the selected doctors

(claim 11) and identify a doctor in a particular location by using the Internet (Bonin: [0038], wherein "the medium" refers to video representations of physicians for the consumer to select from, delivered to the consumer "...by a stream of data over the internet...");

and

(claim 12) via a toll free telephone number (Bonin [0031], reads on "teleservices video bio-phone line").

G. As per claim 13, Bonin discloses a method as recited in claim 1, wherein the selected doctors

possess excellent credentials, as judged by the organization (Bonin: [0016]-[0020]. Note that the disclosed method includes preparing physicians for "proper performance expectations" [0016] geared toward inducing a patient to select them to be that patient's doctor. This includes



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the use of "predetermined guidelines and standards"... [for]..."Portrayal of the physician...to convey physician...credentials..." [0020]. The Examiner considers that average or mediocre credentials would not be considered helpful in such a portrayal, and that only high quality - i.e. "excellent" - credentials would be judged by the organization to be worthy of portrayal, and that this would be included in the guidelines and standards of the organization.).

H. As per claim 14, Thomas discloses a method as recited in claim 1, wherein

the associated doctors pay a fee to be associated with the organization (Bonin: [0029], note the disclosed determination of a "...return on investment based on at least a cost to produce the video visit videotape..." The Examiner considers this "investment" to be read on by fee.).

I. As per claim 18, Thomas discloses a method as recited in claim 1, wherein

the members pay the membership fee to a credit card company (Thomas: [0019], fee reads on "rebates").

J. As per claim 19, Thomas discloses a method as recited in claim 18,



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wherein the credit card company pays an associated doctor for conducting a visit with a member of the organization (Thomas: [0041], discloses “instantaneous transfer of funds” by use of a card to health care “...providers who provide a discount of their services to the clients.”).

K. As per claim 20, Thomas discloses a method as recited in claim 1, wherein

the membership fee is non-subsidized (Thomas: [0036], note the disclosed payment of deductibles. The Examiner notes that deductibles may vary between consumers having the same insurance payer, for instance an older person who is more likely to be sick than a younger person might have to assume a higher deductible policy than the younger person. This contrasts to the description provided in Applicant's specification on page 5, where a “subsidized pricing structure is one where patients typically pay the same price regardless of their medical situation”).)

L. As per claim 21, Bonin discloses a method as recited in claim 1, wherein

the associated plurality of doctors are private practitioners (Bonin: [0040], reads on “practice group”).



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7. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonin in view of Thomas as applied to claim 2 above, and further in view of Tuzhilin (US Pat# 6,236,978, hereinafter Tuzhilin).

A. As per claims 3-7, Bonin discloses a plurality of ways to conduct market research (Bonin: [0042]) and to promote the video visit system (Bonin: [0041]) which suggest the features recited in claims 3-7, though the combined teachings of Bonin and Thomas fail to explicitly teach the features of claims 3-7.

However, these features are well known in the art as evidenced by the teachings of Tuzhilin, who discloses a system for dynamically profiling the purchasing characteristics of individual users, and aggregating these profiles into more generalized rules that characterize groups of users (Tuzhilin : col 2, lns 24-59; col 3, lns 30-35).

i. As per claim 3, Tuzhilin discloses a method as recited in claim 2, wherein

the credit card company offers membership to the organization to a potential member based on purchasing characteristics of the potential member (Tuzhilin: col 3, lns 30-33, reads on "user profiles").

ii. As per claim 4, Tuzhilin discloses a method as recited in claim 3, wherein



the purchasing characteristics of the potential member comprises frequent travel (Tuzhilin: col 3, Ins 30-34, reads on business travel locations).

iii. As per claim 5, Tuzhilin discloses a method as recited in claim 3, wherein the purchasing characteristics of the potential member comprises

frequent international travel (Tuzhilin: col 11, Ins 25-29).

iv. As per claim 6, Tuzhilin discloses a method as recited in claim 3, wherein the purchasing characteristics of the potential member comprises

high spending (Tuzhilin: col 3, Ins 63-64, reads on "...prefers to have lunches at expensive seafood restaurants..." ).

v. As per claim 7, Tuzhilin discloses a method as recited in claim 3, wherein the purchasing characteristics of the potential member comprises

a high income (Tuzhilin: col 6, Ins 17-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disclosures of Tuzhilin with the collective teachings of Bonin and Thomas with the motivation of generating more reliable dynamic profiles by analyzing a large number of rules (Tuzililn: col 3, Ins 11-21), thus



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providing improved purchasing recommendations to users (Tuzhilin: col 10, Ins 50-55), for the purchase of health insurance for instance.

8. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonin in view of Thomas as applied to claim 1 above, and further in view of Sato (US Pat# 5,911,687, hereinafter Sato).

A. As per claims 15-17, the features of these claims are not explicitly disclosed by the combined teachings of Bonin and Thomas. However, these features are well known in the art as evidenced by the teachings of Sato

i. As per claim 15, Sato teaches a method as recited in claim 1, wherein

the visit a member seeks with an associated doctor is provided immediately (Sato: Fig. 9; col 9, Ins 55-61).

ii. As per claim 16, Sato discloses a method as recited in claim 1, wherein

an associated doctor shares medical information regarding a member of the organization with other associated doctors using the Internet (Sato: Fig 1, item 100, Internet reads on "wide area network"; col 5, Ins 44-58. Note that the plurality of doctors in the patients clinic – Fig 1, item 102 - share



the same patient history information through the management center, see Fig 1, item 104).

iii. As per claim 17, Sato discloses a method as recited in claim 1, wherein

the organization can import and store a member's medical records from the member's regular doctor or primary health care provider (Sato: col 6, ln 65 to col 7, ln 10).

For claims 15-17, it would have obvious to one of ordinary skill in the art at the time of the invention to incorporate the disclosure of Sato with the combined teachings of Bonin and Thomas with the motivation of extending the geographic reach of a patient with respect to the patient's ability to receive convenient medical treatment from physicians selected by the patient (Sato: col 1, ln 65 to col 2, ln 5).

9. As per claim 22, all the limitations recited in claims 1-21 are combined into this single claim, thus the limitations in claim 22 are rejected for the same reasons and motivations as provided for the corresponding limitations in claims 1-22.

Claim 22 reads as follows:



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A method of providing preferred patient services, comprising:

associating a plurality of doctors in various locations with an organization, the associated doctors being selected by the organization based on each doctor's respective credentials; and

charging a membership fee to allow a plurality of members to belong to the organization, the members being permitted to seek any number of visits with any of the associated doctors in any of the various locations,

wherein the organization does not provide health insurance, but provides additional medical care regardless of any health insurance a member may already possess,

wherein the organization is promoted through a credit card company,

wherein the credit card company offers membership to the organization to a potential member based on purchasing characteristics of the potential member,

wherein the purchasing characteristics of the potential member comprises frequent travel,



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wherein the purchasing characteristics of the potential member comprises frequent international travel,

wherein the purchasing characteristics of the potential member comprises high spending,

wherein the purchasing characteristics of the potential member comprises a high income,

wherein the various locations comprise various cities,

wherein the various locations comprise various countries,

wherein the selected doctors comprises a preexisting network of doctors,

wherein a member can access a list of the selected doctors and identify a doctor in a particular location by using the Internet,

wherein a member can access a list of the selected doctors via a toll free telephone number,

wherein the selected doctors possess excellent credentials, as judged by the organization,





wherein the associated doctors pay a fee to be associated with the organization,

wherein the visit a member seeks with an associated doctor is provided

immediately,

wherein an associated doctor shares medical information regarding a member of the organization with other associated doctors using the Internet,

wherein the organization can import and store a member's medical records from the member's regular doctor or primary health care provider,

wherein the members pay the membership fee to a credit card company,

wherein the credit card company pays an associated doctor for conducting a visit with a member of the organization,

wherein the membership fee is non-subsidized,

wherein the associated plurality of doctors are private practitioners.

10. As per claim 23, it combines into this single claim the limitations of claims 1, 11, 18, and 19, thus the limitations in claim 23 are rejected for the same



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reasons and motivations as provided for the corresponding limitations in claims 1, 11, 18, and 19.

Claim 23 reads as follows:

A method of providing preferred patient services, comprising:

associating a plurality of doctors in various locations with an organization, the associated doctors being selected by the organization based on each doctor's respective credentials; and

charging a membership fee to allow a plurality of members to belong to the organization, the members being permitted to seek any number of visits with any of the associated doctors in any of the various locations,

wherein the organization does not provide health insurance, but provides additional medical care regardless of any health insurance a member may already possess,

wherein the member pay the membership fee to a credit card company,

wherein the credit card company pays an associated doctor for conducting a visit with a member of the organization,

wherein an associated doctor shares medical information regarding a member of the organization with other associated doctors using the Internet.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied patent prior art discloses a method for credentialing physicians for actuarial purposes (US Pat# 6,862,571).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

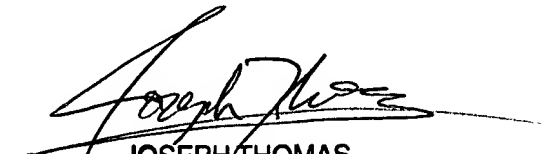
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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12/02/2005



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